bookseller's website, the bookseller sends the potential customer's identification information to the apparatus. The apparatus then retrieves the potential customer's online activity history, and based on that history generates a tailored promotions of goods and/or services offered by the bookseller. For example, where the potential customer's online activity indicates an interest in finance and investing, the apparatus would generate a promotion of books offered by the bookseller that pertain to the stock market and to personal financial management. Where the potential customer's online activity might indicate an interest in travel, the apparatus would generate a promotion of books offered by the bookseller that pertain to travel guides or hotel information. The tailored promotion is then sent by the apparatus to the requesting website, where it is sent to the accessing consumer.

As previously explained, Gardenswartz generally teaches away from the use of a consumer's online activity for targeting advertisements at consumers (see col. 2, ll. 43-48). Instead, Gardenswartz teaches using a registered consumer's offline purchase histories to send targeted advertisements to the consumer's computer when the presence of the registered consumer is detected on the Internet. But more significantly, Gardenswartz fails to disclose any system or method whereby an apparatus "receives from a particular subscriber network site consumer identifier information associated with a consumer requesting access to that subscriber network site, uses said stored activity information in conjunction with said goods and/or services promotion data in said database to create a tailored promotion of goods and/or services offered by said particular subscriber network site in response to said received consumer identifier information, and transmits said tailored promotion to said particular subscriber network site for presentation to said consumer" as set forth in claim 1. Gardenswartz simply discloses sending to an online consumer's computer a targeted advertisement based on the consumer's offline purchase history. The targeted advertisement is wholly unrelated to any website to which the consumer may be viewing or requesting access.

The Examiner apparently recognizes that Gardenswartz fails to disclose any system or method where there are subscribers to a tailored promotion-generating apparatus, as evidenced by the Examiner's construing the term "subscriber" as meaning one who expresses concurrence or assent, as to a belief or notion. The Examiner's

interpretation of the term "subscriber" as used in the claims is improper; however, even if it were not, the requirements of the claims would still not be met by the proposed combination of references. In particular, neither Gardenswartz nor Roth nor Travis teach or suggest the use of stored online activity information in conjunction with goods and/or services promotion data in a database to create a tailored promotion of goods and/or services offered by a particular subscriber network site that sent to the apparatus consumer identifier information associated with a consumer requesting access to that subscriber network site. The Examiner has never come to terms with this specific claim language and has failed to explain where such feature is disclosed or suggested by the applied prior art.

The Examiner's construction of the term "subscriber" as meaning an adherent to a belief or notion is improper because such construction does not comply with the standard of claim interpretation that must be used in examination, i.e. the broadest reasonable interpretation consistent with the specification. In particular, throughout the specification, the term "subscriber" is used in the context of one who receives a service from a service provider, as in a "telephone subscriber." Construing "subscriber" as one who expresses concurrence with or assent to a notion or belief is blatantly inconsistent with the specification as such construction makes no sense in the context of the description of the invention as presented in the specification (or for that matter, as used in the claims), and is thus improper as a matter of law.

The Examiner continues to argue that Gardenswartz "discloses in the Background, using online activity of IP addresses visited and online purchases made to target ads," but the Examiner has failed to address applicant's argument that Gardenswartz teaches away from such use of online consumer activity history and thus Gardenswartz cannot be used to supply such teaching in an obviousness rejection under 35 U.S.C. § 103. It is incorrect to state that Gardenswartz "teaches" in the Background of the Invention the use of online activity to develop targeted ads, when the rejection is based on a combination of Gardenswartz with additional prior art. While the concept of "teaching away" may not apply to anticipation rejections under 35 U.S.C. § 102, Celeritas Techs., Ltd. v. Rockwell, 150 F.3d 1354, 47 USPQ2d 1516 (Fed. Cir. 1998), when a rejection is based on a proposed combination of prior art under an obviousness theory, the entire

disclosure of the prior art must be considered as a whole for what it suggests, and what it discourages to those of ordinary skill in the art. In re Haruna, 249 F.3d 1327, 58 USPQ2d 1517 (Fed. Cir. 2001).

Here, Gardenswartz clearly teaches away from the claimed invention such that no one of ordinary skill in the art having read Gardenswartz would have been led to make the combination proposed in the Office action, i.e., to have used online activity to target ads with the methods disclosed by Roth or Travis. The Examiner has only concluded that "one of ordinary skill would find it obvious to combine the disclosure of targeting ads using online activity" without providing any basis to support such conclusion such as by pointing out any teaching, suggestion or motivation in Gardenswartz to do so, and by completely ignoring Gardenswartz's explicit teaching away from doing so, at col. 2, ll. 43-48.

Consequently, no combination of Gardenswartz with either or both of Roth or Travis would result in the claimed invention under 35 U.S.C. § 103.

Conclusion

In view of the foregoing, favorable reconsideration of this application, withdrawal of the outstanding grounds of rejection, and the issuance of a Notice of Allowance are earnestly solicited.

Please charge any fee or credit any overpayment pursuant to 37 CFR 1.16 or 1.17 to Deposit Account No. 02-2135.

RESPECTFULLY SUBMITTED,			
NAME AND REG. NUMBER	Vincent M. DeLuca Attorney for Applicants Registration No. 32,408		
SIGNATURE	Vincent M DeLuca	DATE	14 OCT 03

Address	Rothwell, Figg, Ernst & Manbeck 1425 K Street, N.W., Suite 800				
City	Washington	*State*	D.C.	*Zip Code*	20005
Country	U.S.A.	*Telephone*	202-783-6040	*Fax*	202-783-6031